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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COLIN, CARL G

ART UNIT PAPER NUMBER

2136

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

.09/764,602

Applicant(s)

HIRAI, JUN

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 18 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Pursuant to USC 131, claims 1-52 are presented for examination.

Drawings

2. Figure 1 is objected to as failing to comply with 37 CFR 1.84(p)(5) because it does not include reference signs: reference number (100) in the description on p. 11, paragraphs 0045 and 0049, and 0051. Appropriate correction is required.

- 2.1 Figure 4 is objected to as failing to comply with 37 CFR 1.84(p)(5) because it does not include reference signs: reference number (100) in the description on p. 16, paragraph 0071. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 11, 21, 27, 33, 43, and the intervening claims are rejected under 35

U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The method, system, and apparatus of these claims do not refer to any computer hardware or software.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate lines of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of lines (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.1 **Claims 1-52** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,574,609 to **Downs et al.**

4.2 **As per claims 1, 11, and 21, Downs et al.** discloses a distribution method, system and apparatus for distributing content owned by a predetermined right owner, comprising: issuing to a distributor authentication information indicating a consent to use the content, for example (see column 11, lines 5-25); distributing the content via a predetermined distribution path with the authentication information attached thereto, for example (see column 11, lines 5-52); and

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monitoring the distribution of the content in the predetermined distribution path, for example (see column 11, lines 5-52).

As per claim 27, Downs et al. discloses method for monitoring use of content owned by a predetermined right owner, comprising: issuing to a content user authentication information indicating a consent to use the content, for example (see column 10, line 60 through column 11, line 25).

As per claims 33 and 43, Downs et al. discloses method for using content after receiving a consent to use from a predetermined right owner, comprising: receiving authentication information indicating the consent to use, for example (see column 10, line 60 through column 11, line 25); and using the content with the authentication information attached thereto, for example (see column 10, line 60 through column 11, line 25).

As per claims 2 and 12, Downs et al. discloses the limitation of wherein said monitoring step includes obtaining content being distributed in the predetermined distribution path and determining the validity of the content distribution operation based on whether the authentication information is attached to the content, for example (see column 11, lines 5-52).

As per claims 3, 13, and 22, Downs et al. discloses the limitation of wherein the authentication information includes time identification information showing the current time and distributor identification information assigned to the distributor, for example (see column 38, line

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34 through column 39, line 20). **Downs et al.** discloses different parameter that can be part of authentication data.

As per claims 4, 14, and 24, Downs et al. discloses the limitation of wherein said issuing step further includes issuing an encryption key, and said distributing step distributes the content with the attached authentication information encrypted using the encryption key, for example (see column 10, lines 5-18).

As per claims 5 and 15, Downs et al. discloses the limitation of wherein said distributing step embeds the authentication information into the content using a digital watermarking technique, for example (see column 9, lines 39 and column 8, lines 13-30).

As per claims 6 and 16, Downs et al. discloses the limitation of wherein said distributing step embeds the authentication information into a distribution signal of the content using a digital watermarking technique, for example (see column 9, lines 39 and column 8, lines 13-30).

As per claims 7 and 17, Downs et al. discloses the limitation of wherein each content has specific content identification information, said content distribution method further comprising: storing a distribution history for each content distributed via the predetermined distribution path in association with its respective content identification information, for example (see column 56, lines 15-36).

As per claims 8 and 18, Downs et al. discloses the limitation of wherein each content has specific content identification information, said content distribution method further comprising: storing a distribution history for each content distributed via the predetermined distribution path in association with its respective content identification information, for example (see column 9, lines 39-67); and extracting only the distribution history associated with specific content by masking the distribution history with a predetermined filter, for example (see column 9, lines 39-67 see also column 53, section "Work Flow Rules").

As per claims 9, 19, and 26, Downs et al. discloses the limitation of wherein each content has specific content identification information, said content distribution method further comprising: storing a distribution history for each content distributed via the predetermined distribution path in association with its respective content identification information, and managing the distribution of each content based on the distribution history, for example (see column 9, lines 39-67 and column 11, lines 25-38).

As per claims 10 and 20, Downs et al. discloses the limitation of wherein each content has specific content identification information, said content distribution method further comprising: storing a distribution history for each counter distributed via the predetermined distribution path association with its respective content identification information,

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wherein the issuing step issues authentication information containing identification information by which the distribution history can be addressed, for example (see column 9, lines 39-67 and column 56, lines 15-36).

As per claim 23, Downs et al. discloses the limitation of wherein said authentication information includes at least distributor identification information assigned to said distributor and identification information by which a distribution history of the content for said distributor can be addressed, for example (see column 9, lines 39-67 and column 56, lines 15-36).

As per claim 25, Downs et al. discloses the limitation of wherein said authentication information is attached to content distributed based on said consent to use, said apparatus further comprising: a unit operable to determine whether said authentication information is attached to distributed content, for example (see column 11, lines 5-52).

As per claim 28, Downs et al. discloses the limitation of wherein the authentication information includes at least time identification information showing the current time and distributor identification information assigned to the content user, for example (see column 38, line 34 through column 39, line 20).

As per claim 29, Downs et al. discloses the limitation of wherein the authentication information includes at least distributor identification information assigned to the distributor and

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identification information by which a distribution history of the content for the content user can be addressed, for example (see column 9, lines 39-67 and column 56, lines 15-36).

As per claim 30, Downs et al. discloses the limitation of further comprising issuing to the content user an encryption key in addition to the authentication information, for example (see column 10, lines 5-18).

As per claim 31, Downs et al. discloses the limitation of further comprising: using the content for which there is a consent to use with the authentication information attached thereto; and determining whether the authentication information is attached to content being used, for example (see column 11, lines 5-52).

As per claim 32, Downs et al. discloses the limitation of further comprising: managing a use status of the content based on a content use history of the content user, for example (see column 11, lines 25-40).

As per claims 34 and 44, Downs et al. discloses the limitation of wherein said using step distributes the content and the attached authentication information via a predetermined distribution path, for example (see column 11, lines 5-52).

As per claims 35 and 45, Downs et al. discloses the limitation of wherein the authentication information includes at least time identification information showing the current

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time and user identification information assigned to the user, for example (see column 38, line 34 through column 39, line 20).

As per claims 36 and 46, Downs et al. discloses the limitation of wherein the authentication information includes at least distributor identification information assigned to the distributor and identification information by which a use history of the content for the distributor can be addressed, for example (see column 9, lines 39-67 and column 56, lines 15-36).

As per claims 37 and 47, Downs et al. discloses the limitation of wherein said receiving step receives an encryption key in addition to the authentication information, and said using step uses the content with the attached authentication information encrypted using the encryption key, for example (see column 10, lines 5-18).

As per claims 38 and 48, Downs et al. discloses the limitation of wherein said using step embeds the authentication information into the content using a digital watermarking technique, for example (see column 9, lines 39 and column 8, lines 13-30).

As per claims 39 and 49, Downs et al. discloses the limitation of wherein said using step embeds the authentication information into a distribution signal of the content using a digital watermarking technique, for example (see column 9, lines 39 and column 8, lines 13-30).

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As per claims 40 and 50, Downs et al. discloses the limitation of wherein each content has specific content identification information, said method further comprising: storing a use history for each content used in said using step in association with its specific content identification information, for example (see column 9, lines 39-67 and column 56, lines 15-36).

As per claims 41 and 51, Downs et al. discloses the limitation of wherein each content has specific content identification information, said method further comprising: storing a use history for each content used in said using step in association with its specific content identification information, for example (see column 9, lines 39-67); and extracting only the use history associated with specific content by masking the stored use history with a predetermined filter, for example (see column 9, lines 39-67 see also column 53, section "Work Flow Rules").

As per claims 42 and 52, Downs et al. discloses the limitation of wherein each content has specific content identification information, said method further comprising: storing a use history for each content used in said using step in association with its specific content identification information; and managing a use status of each content based on the stored use history, for example (see column 9, lines 39-67 and column 11, lines 25-38).

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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses a method and system for distributing content associated with authentication information.

US Patents:	6,587,127	Leeke et al.
	6,687,802	Kori et al.

5.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc

Carl Colin

Patent Examiner

July 8, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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